REMARKS

This Response is in reply to the non-final Office Action mailed on December 2, 2003. Claims 1 and 3-8 have been amended and remain pending in this application. Claims 2 and 9 have been cancelled. No new matter has been added. Entry and reconsideration of the following amendments and remarks is respectfully requested.

In paragraph 1, the Examiner stated that the disclosure is objected to because of informalities on page 6 of the specification. The Applicant has amended the specification to correct minor informalities on page 6 as the Examiner requested. Also, minor informalities on page 7 have been corrected. Therefore, withdrawal of the objection is respectfully requested.

In paragraph 2, claims 1-7 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out the claimed invention. Specifically, claims 1 and 7 included the terms "so-called" and "or the like" which the Examiner pointed out as being vague. Also, claims 4 and 7 included limitations that lacked antecedent basis. The Applicant has amended the claims to delete these terms and correct limitations without antecedent basis. Also, claims 3, 5 and 7 have been amended to further clarify the present invention. Accordingly, withdrawal of the rejection is respectfully requested.

In paragraph 5 of the Office Action, claims 1 and 4-8 were rejected under 35 USC § 102(b) as being anticipated by Malkki et al. ("Malkki"). Applicants assert that the amended claims are patentable over Malkki.

In prior inventions, the guide jaw causes a pressure peak when it hits the reeling cylinder, and a corresponding loading peak in the reel-up process, as illustrated by pressure peak P in Fig. 2 of the Applicants' figures. Referring to the Malkki reference (also discussed on page 2, last paragraph of the present application), even though there is no peak shown in Figs. 5 and 6, as contrasted to Fig. 4 of Malkki, the actual situation is that when the secondary forks hit the reel shaft, there is always a narrow peak.

In Applicants' invention, the contact of the loading device with the reeling shaft occurs without a loading force because the loading actuators are devoid of a force which effects the linear load. A linear load P is not generated because the additional loading exerted on the reeling shaft at the stage when the reeling shaft is transferred from the initial reeling device to the loading of the loading device is not present. Therefore, the position of the guide jaws and the adjustment of the force of the loading device before the transfer stage prevent a loading peak from disturbing the reeling process.

For the reasons set forth above, it is the Applicants' contention that the claims 1 and 4 of the present invention are not anticipated by the cited prior art. Also, independent method claims 1, 4 and 8 have been amended to further clarify the Applicants invention. Claim 1 has been amended to

include claim 2; claim 4 has been amended to include independent claim 1; and claims 8 and 9 have been combined. By reason of their dependency on independent claims 1 and 4, Applicants assert that claims 5-7 are also patentable over the cited prior art. It is therefore respectfully requested that the rejections be withdrawn.

In paragraphs 6 and 7 of the Office Action, claims 1-9 were rejected under 35 USC § 102(e) as being anticipated by Tuominen et al. ("Tuominen") and claims 1-9 were rejected under 35 USC § 102(f) because the Examiner states that the Applicant did not invent the claimed subject matter, respectively.

The Applicants assert that Tuominen et al. (U.S. 6,145,778) is not a valid reference as a bar against the present patent application. 35 USC § 102(e) is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant." Therefore, foreign applications' filing dates that are claimed in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 USC § 102(e) for prior art purposes. Specifically, foreign priority can be used to defend an U.S. patent application (to make the effective date earlier than that of a reference), but it can not be used as a § 102(e) bar.

In this case, Touminen's U.S. filing date of Mar. 16, 1999 was later than the Applicants' priority date of Jan. 12, 1999. The earliest U.S. filing date that the Tuominen reference can rely on is Apr. 10, 1998, which is the filing of U.S. provisional application 60/081,325. However, the features and description (referred to as passage "col. 8, lines 14 to 30" by the Examiner) related to

the claims of the present application are not disclosed in U.S. provisional application 60/081,325. The features are disclosed only in the U.S. non-provisional application dated Mar. 16, 1999, which is the valid § 102(e) date. That priority date (Mar. 16, 1999) is posterior to the priority date of the present application. The present invention was disclosed in the Finnish patent application No. FI-990044 on Jan. 12, 1999, on which Applicants' priority is based.

With regard to the § 102(f) rejection, as stated above, the present invention was first disclosed in the Finnish patent application No. FI-990044 on Jan. 12, 1999. The invention was not disclosed in the earlier applications by others, nor was the invention derived from an inventor of the Tuominen patent.

Therefore, it is Applicants' contention that Tuominen does not anticipate the present invention. Furthermore, it is contended that the features of the present invention were disclosed first by the Applicants. It is therefore respectfully requested that the rejections be withdrawn.

Applicant submits herewith a certified translation of Finnish patent application No. FI-990044 which has a priority date of January 12, 1999, priority of which was previously claimed in the present application. The certified translation is enclosed as evidence for your review.

Conclusion

In view of the above presented amendments and remarks, the Applicants believes that all claims in this application should now overcome the cited prior art and be in condition for allowance. Reconsideration of the present application and claims, as amended, is respectfully requested.

Applicant notes that there is no indication that the drawings are acceptable. Please provide indication that the drawings are accepted by the Examiner in the next formal communication.

A petition for a three-month extension of time with the requisite fee is attached herewith. In the event that any other extensions and/or fees are required for the entry of this Amendment, the Patent and Trademark Office specifically authorized to charge such fee to Deposit Account No. 50-0518 in the name of Steinberg & Raskin, P.C.

If the Examiner feels that it might be helpful in advancing this application to issuance by calling the undersigned, the Applicants would greatly appreciate such a telephone interview.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,
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